

Application No. 10/638,981
Amendment "A" dated July 15, 2005
Reply to Office Action mailed February 15, 2005

REMARKS / ARGUMENTS

Introduction

The present Amendment is in response to the Examiner's Office Action mailed February 15, 2005. Claims 1-41 are now pending in view of this response.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Double Patenting Rejections Under 35 U.S.C. § 101

The Office Action mailed February 15, 2005 provisionally rejected claims 1-41 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-27 of co-pending Applications Serial No. 10/639,064. The rejection is provisional since claims of the co-pending application have not been patented yet.

35 U.S.C. § 101 prevents two patents from issuing on the same invention. In this case, "same invention" means identical subject matter. *See* MPEP § 804(II)(A). A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *See In Re Vogel* 422 F.2d 438, 164 USPQ 619 (CCPA 1970). In other words, if there is an embodiment of the invention that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting would not exist. *See* MPEP § 804(II)(A). An example of where a double patenting rejection under 35 U.S.C. § 101 is improper is given in the MPEP, which states that an "invention defined by a claim reciting a compound having a 'halogen' substituent is not identical to or substantively the same as a claim

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reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." As a result, a double patenting rejection under 35 U.S.C. § 101 is not proper unless the two patents claim identical subject matter. *See* MPEP § 804(II)(A).

The following discussion illustrates that statutory double patenting does not exist between the claims of the present invention and the claims 1-27 of co-pending Application Serial No. 10/639,064 in accordance with MPEP § 804(II)(A). The following discussion addresses each set of claims in the present application with respect to all the claims in co-pending Application Serial No. 10/639,064 in turn.

More particularly, the following discussion illustrates that some of the claims in of Application No. 10/639,064 do not have the same elements as claims in the present application or vice versa. The following discussion also illustrates that some of the claims or claim elements in of Application No. 10/639,064 may have a different scope than the claims in the present invention. Either of these showings demonstrates that the claims do not cover identical subject matter as required for double patenting rejections under 35 U.S.C. § 101 and in accordance with MPEP § 804(II)(A).

Claims 1-14 of the Present Application

Claim 1 of the present application is directed to a card cage system that requires:

- (a) first and second end card guides disposed within the electronic equipment enclosure;
- (b) a middle card guide interposed between the first and second end card guides in a spaced apart arrangement and cooperating with the first and second end card guides to define at least one card storage level; and
- (c) first and second adapter elements joined to the first and second end card guides, respectively, and a third adapter element configured to be removably joined to the middle card guide, the adapter elements cooperating with the card guides so that a first card storage configuration is defined when the adapter elements are joined to the corresponding card guides, and a second card storage configuration being defined when adapter elements are present in only two of the card guides.

Claim 1 of Application No. 10/639,064 reference is directed to an adapter element, not a card cage system as required by claim 1 of the present application. Claim 1 of Application No.

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10/639,064 also requires each adapter element to have a card guide interface portion and a functional module interface portion. The structure of each adapter element required in claim 1 of Application No. 10/639,064 is not required in claim 1 of the present application. None of the claims 1-14 in the present application requires the structure of each adapter element in claim 1 of Application No. 10/639,064. Therefore, there are embodiments that fall within the scope of claim 1 of Application No. 10/639,064 that are not within the scope of claim 1 of the present application and vice versa. For at least these reasons, claims 1-10 of Application No. 10/639,064 do not cover the identical subject matter of claims 1-14 of the present application.

Claim 11 of Application No. 10/639,064 is directed to a card cage system. Claim 11 requires, however, a plurality of card guides. A plurality of card guides includes 2 or more card guides. Claim 1 of the present application, however, requires first and second end card guides and a middle card guide. Because claim 1 requires a total of three card guides and a plurality of card guides may include only 2 card guides, claim 11 of Application No. 10/639,064 does not cover the identical subject matter of claim 1 of the present invention. For at least the same reasons, Claims 11-12, and 14-20 of Application No. 10/639,064 do not cover the identical subject matter of claims 1-14 of the present invention.

Claim 13 of Application No. 10/639,064, while requiring first and second end card guides and a middle card guide, also requires means for facilitating definition of multiple card storage configuration as defined in claim 11 of Application No. 10/639,064. Claim 15 of Application No. 10/639,064 indicates that the means for facilitating definition of a plurality of card storage configurations comprises a plurality of adapter elements. As indicated above, a plurality of adapter elements can be satisfied with 2 adapter elements. Claim 1 of the present application, however, requires first, second, and third adapter elements. As a result, claim 13 of Application No. 10/639,064 does not cover the identical subject matter of claims 1-14.

Claim 21 of Application No. 10/639,064 is directed to an electronic equipment enclosure and requires a chassis. None of the claims 1-14 in the present application require a chassis. Therefore claims 21-26 of Application No. 10/639,064 do not cover the identical subject matter as claims 1-14 of the present application.

Claim 27 is directed specifically to an adapter element and requires a card guide interface portion and a functional module interface portion attached to the card guide interface portion.

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Claims 1-14 are directed to a card cage system and include limitations that are not required by claim 27. As a result, claim 27 does not cover the identical subject matter as claims 1-14 of the present application.

Claims 15-20 of the Present Application

Claim 15 of the present application is directed to a card cage system that requires:

- (a) first and second end card guides disposed within the electronic equipment enclosure;
- (b) a middle card guide interposed between the first and second end card guides in a spaced apart arrangement and cooperating with the first and second end card guides to define at least one card storage level; and
- (c) means for facilitating definition of multiple card storage configurations, the means for facilitating definition of multiple card storage configurations facilitating definition of first and second card storage configurations at the at least one card storage level.

Claims 1-10 of Application No. 10/639,064 are directed to an adapter element that requires a card guide interface portion and a functional module interface portion attached to the card guide interface portion. The structure is not present in claim 15 of the present application, which requires means for facilitating definition multiple card storage configurations. None of the dependent claims 16-20 of the present application recites the structure included in claim 1 of Application No. 10/639,064. As a result, claims 1-10 of Application No. 10/639,064 do not cover the identical subject matter as claims 15-20 of the present application.

Claim 11 of Application No. 10/639,064 is directed to a card cage system and requires a plurality of card guides. A plurality of card guides includes 2 or more card guides. Claim 15 of the present application, however, requires first and second end card guides and a middle card guide. Because claim 15 requires a total of three card guides and a plurality of card guides may include only 2 card guides, claim 11 of Application No. 10/639,064 does not cover the identical subject matter of claim 15 of the present invention. For at least the same reasons, Claims 11-12, and 14-20 of Application No. 10/639,064 do not cover the identical subject matter of claims 15-20 of the present invention.

Claim 13 of Application No. 10/639,064, while requiring first and second end card guides and a middle card guide, also requires means for facilitating definition of multiple card storage

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configuration as defined in claim 11. However, the means for facilitating definition of multiple card storage configurations in claim 15 of the present application requires the definition of first and second card storage configurations at the least one card storage level. Claim 13 of Application No. 10/639,064, while requiring first and second end card guides and a middle card guide, also requires means for facilitating definition of multiple card storage configuration as defined in claim 11. Claim 11, however, does not include the requirement of facilitating definition of first and second card storage configurations at the at least one card storage level. For at least these reasons, claim 13 of Application No. 10/639,064 does not cover the identical subject matter of claims 15-20 of the present application.

Claim 21 of Application No. 10/639,064 is directed to an electronic equipment enclosure and requires a chassis. None of the claims 15-20 in the present application require a chassis. Therefore, claims 21-26 of Application No. 10/639,064 do not cover the identical subject matter as claims 15-20 of the present application.

Claim 27 is directed specifically to an adapter element and requires a card guide interface portion and a functional module interface portion attached to the card guide interface portion. Claims 15-20 are directed to a card cage system and include limitations that are not required by claim 27 (first and second end card guides, a middle card guide, etc.). As a result, claim 27 does not cover the identical subject matter as claims 15-20 of the present application.

Claims 21-29 of the Present Application

Claim 21 of the present invention is directed to a card guide and requires:

(a) first and second support structures that cooperate to at least partially define a pair of channels configured to receive at least a portion of a card, one channel being located on either side of the card guide, the channels terminating short of the first end of the card guide so that a slot is defined that is interposed between the first and second support structures, and the first and second support structures further cooperating to define a receptacle in communication with the slot so that in a first card storage configuration, a card received in the electronic equipment enclosure by way of the receptacle is positioned in the slot such that the card straddles the card guide;

(b) a connecting member at least indirectly joined to one of the first and second support structures.

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Claim 21 is directed to a card guide itself and an embodiment that falls within the scope of claim 21 does not fall within the scope of any of the claims 1-17 of Application No. 10/639,064. As a result, claims 1-27 do not cover the identical subject matter as claims 21-29 of the present application.

For example, claim 1 of Application No. 10/639,064 is directed to an adapter element and not to a card guide. Further, the adapter element of claim 1 requires a card guide interface portion and a functional module interface portion. These elements of claim 1 of Application No. 10/639,064 are not required in claim 21 of the present application. As a result, claims 1-10 of Application No. 10/639,064 do not cover the identical subject matter as claims 21-29 of the present application.

Claim 11 of Application No. 10/639,064 is directed to a card cage system and requires a plurality of card guides and means for facilitating definition of multiple card storage configurations. These elements are not present or required by claims 21-29 of the present application. Thus, claims 11-20 of Application No. 10/639,064 do not cover the identical subject matter as claims 21-29 of the present application.

Claim 21 of Application No. 10/639,064 is directed to an electronic equipment enclosure and requires a chassis in addition to a card cage system. A chassis is not required by claims 21-29 of the present invention. As a result, there are embodiments that could satisfy claims 21-29 without satisfying claims 21-26 of Application No. 10/639,064. Therefore, claims 21-26 of Application No. 10/639,064 do not cover the identical subject matter as claims 21-29 of the present application.

Claim 27 of Application No. 10/639,064 is directed to an adapter element while claims 21-29 of the present application are directed to a card guide. The elements of claims 21-29 are not found in claim 27 of Application No. 10/639,064. As a result, claim 27 of Application No. 10/639,064 does not cover the identical subject matter as claims 21-29 of the present application.

Claims 30-41 of the Present Application

Claim 30 is directed to an electronic equipment enclosure and requires:

- (a) a chassis; and
- (b) a card cage system substantially disposed within the chassis and comprising:

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- the card cage system comprising:
- (i) first and second end card guides;
 - (ii) a middle card guide interposed between the first and second end card guides in a spaced apart arrangement and cooperating with the first and second end card guides to define at least one card storage level; and
 - (iii) first and second adapter elements joined to the first and second end card guides, respectively, and a third adapter element configured to be removably joined to the middle card guide, the adapter elements cooperating with the card guides so that a first card storage configuration is defined when the adapter elements are joined to the corresponding card guides, and a second card storage configuration being defined when adapter elements are present in only two of the card guides.

Claim 30 of the present invention requires a chassis. Because of this requirement, embodiments of the invention that could satisfy claims 1-19, and 27 of Application No. 10/639,064 could be satisfied without satisfying claim 30 of the present invention. As a result, claims 1-19 and 27 of Application No. 10/639,064 do not cover the identical subject matter as claims 20-41 of the present application.

Claim 21 of Application No. 10/639,064 requires, in addition to the chassis, a card cage system with a plurality of card guides and a plurality of adapter elements. As previously discussed, a plurality of card guides can be satisfied with 2 card guides and a plurality of adapter elements can be satisfied with 2 adapter elements. Claim 30 of the present application requires a first, second, and middle card guide as well as first, second, and third adapter elements. As a result, an embodiment that falls within the scope of claim 21 (which requires a plurality of card guides and a plurality of adapter elements) of Application No. 10/639,064 does not fall within the scope of claim 30 of the present application. Therefore claim 21 of Application No. 10/639,064 does not cover the identical subject matter as claim 30 of the present application. Further, none of the claims 22-26 of Application No. 10/639,064 recite first, second, and middle card guides and/or first, second, and third adapter elements. As a result, claims 22-26 of Application No. 10/639,064 do not cover the identical subject matter as claims 31-41.

Conclusion

In view of the foregoing, Applicants believe the claims are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application

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that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 15th day of July 2005.

Respectfully submitted,



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